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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1956.

No. 1007

BLOCK DRUG CO., AMM-I-DENT, INC., AND F. W. WOOLWORTH CO.,

Petitioners,

vs.

THE UNIVERSITY OF ILLINOIS FOUNDATION,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

PETITIONERS' REPLY BRIEF IN SUPPORT OF THEIR PETITION FOR A WRIT OF CERTIORARI.

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PETITIONERS SEEK AN ADJUDICATION OF IMPORTANT QUESTIONS OF FEDERAL LAW.

Respondent's brief is not an answer to the Petition for a Writ of Certiorari. It avoids any discussion of the questions presented. Instead, it attempts to justify the holdings of the courts below on certain of the factual issues.

On page 2 of its brief, Respondent states that Petitioners do not attack any specific findings of the District Court. This is correct. The findings of the District Court are not in any way involved in this Petition. The findings on the factual issues are not challenged in any manner and are accepted as true for the purposes of this Petition. Indeed, if the Petition consisted of an argument on the findings, there would be no basis for the Petition. What Petitioners have done, consistent with the rules of this Court, is to point out significant questions of federal law raised by the holdings below which provide a basis for the grant of a Writ of Certiorari.

The Petition does not seek a trial *de novo*. It raises clear-cut legal questions of sufficient importance in the administration of the patent laws to warrant the exercise of this Court's certiorari jurisdiction.

The First Question.

The first question presented is whether the rule of invention laid down by this Court in the *A & P* case is applicable to chemical patent cases as well as mechanical patent cases.

Respondent avoids the question and merely argues that the facts show that the two chemicals employed by Wach act in concert to produce an effect which is greater than the sum of the individual parts.

Petitioners have shown that the effective holding of the courts below (whether or not the *A & P* case was directly referred to) is to apply a different rule of patentability to a mere mixture of two chemicals than to an aggregation of mechanical parts (Petition, pp. 11-12).

Petitioners contend that a different rule should not apply and that this Court should not permit the landmark *A & P* decision to be so circumscribed. This contention is not met by Respondent.

The Second Question.

The second question presented is whether a patentee can secure the filing date of an earlier filed application which did not contain a disclosure sufficient to support patentability. Again the question posed by Petitioners is ignored by Respondent.

The question arises because neither the parent 1947 application nor Kesel's first continuation-in-part application contained a disclosure sufficient to support the patentability asserted by Kesel in the use of a "critical" minimum of 2% of dibasic. Not until 1952, in Kesel's second continuation-in-part application, did such a disclosure first appear.

Respondent's brief does not take issue with Petitioners' contention that much new matter was added to the second Kesel continuation-in-part application. In fact, Respondent admits that the earlier Kesel applications did not support the alleged criticality of proportions and that the Board of Appeals so held (Brief, p. 9).

Respondent argues, however, that the Patent Office considered the question of new matter and public use (Brief, p. 7) and that, "The rulings below simply gave factual approval to a disclaimed portion of the first application and to the addition of greater proof of utility" (Brief, p. 10). We disagree with Respondent's factual interpretations, but apart from this, they do not appear in the opinions below and they are not relevant to the questions presented.

Despite what Respondent says, both courts below held that the second Kesel continuation-in-part application was entitled to the filing date of the parent 1947 application because the parent application contained a broad, unpatentable claim which served as a link between the applications.

Respondent criticizes Petitioners for not printing the succession of the Kesel applications to show what was added by Kesel to his applications (Brief, pages 7-8). Respondent ignores Appendix A, attached to the Petition at pages 21-26, which clearly shows in bright red ink what was added to the specification of Kesel's second continuation-in-part for the first time in 1952. It is uncontroverted that over half of the disclosure of the Kesel patent was added for the first time in 1952; and it is this new matter which gives rise to the question.

The factual argument set forth by Respondent sidesteps the question presented. As stated in the Petition, the question is an important one of first impression. The Court's ruling on this question will prevent the improper issuance of patents by the artifice of filing an early application with broad, unpatentable claims to thereby secure the benefit of the filing date of the early application when subsequent work is done which for the first time presents the basis for a disclosure sufficient to satisfy the requirements of patentability.

The Third Question.

The first portion of the third question asks whether the selection of optimum proportions by routine experiment can involve invention. The optimum proportion here involved is Kesel's allegedly critical 2% minimum of dibasic.

Respondent attempts to answer this question by stating that Kesel was the first to use the proportions in question (Brief, p. 11) and that Kesel evolved a new theory (Brief, p. 12). However, mere novelty of proportions and of theory could be admitted without answering the question of law involved: Can patentability be present in the routine selection of proportions? Respondent's brief does not address itself to this question.

The second portion of the third question is whether infringement can exist when patentability (synergism) is predicated upon certain proportions and the alleged infringement does not use those proportions. Wach states that certain proportions and ratios of his two chemicals are necessary "where the synergistic effect is desired."

Respondent merely argues that the courts below held that Wach's compositions and Petitioners' compositions were equivalent (Brief, pp. 12-13).

This argument brings Respondent to the very dilemma posed by the Petition (p. 20). If the two compositions are equivalent, Wach must be invalid because Petitioners' compositions are outside the proportions which Wach asserts are necessary for synergism. To avoid this conclusion of invalidity, the position must be taken that synergism is not a requisite for patentability in a chemical case —which is equivalent to saying that the rule of *A & P* does not apply in a chemical case. And this brings us back to the first question presented by the Petition.

CONCLUSION.

Respondent's brief carefully avoids the legal questions which are raised in the questions presented by Petitioners. Respondent does no more than argue factual matters not in issue before this Court in determining whether a Writ of Certiorari should be granted.

The questions presented are important questions of federal law which should be decided by this Court.

For the reasons given in the Petition for a Writ of Certiorari, the Petition should be granted.

Respectfully submitted,

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